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10/525,782	02/28/2005	Michael Neumann	026032-4855	8507

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FOLEY AND LARDNER LLP  
SUITE 500  
3000 K STREET NW  
WASHINGTON, DC 20007

EXAMINER
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HAN, JASON

ART UNIT	PAPER NUMBER
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2875

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12/24/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/525,782	<b>Applicant(s)</b> NEUMANN, MICHAEL	
	<b>Examiner</b> JASON M. HAN	<b>Art Unit</b> 2875	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 11 September 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 16,17,20-28,30-32 and 35-47 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 16,17,20-28,30-32 and 35-47 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### *Response to Arguments*

1. Applicant's arguments filed September 11, 2008 have been fully considered but they are not persuasive.
2. In response to Applicant's amendment and argument regarding Claims 16-17, 20-28, 30-32, 35-43, and 45-47 [Pages 7-17], Misaras (U.S. Patent 6,652,128 B2) remains commensurate to the scope of the claims as stated by the Applicant within the context of the claim language and as broadly interpreted by the Examiner [MPEP 2111], whereby the term, "translucent", is broadly interpreted to mean "permitting passage of light"<sup>1</sup> or "transmitting rays of light without permitting objects to be distinctly seen; partially transparent"<sup>2</sup>. Thus, Misaras clearly teaches a translucent covering layer [Figure 1: (102, 104)] including a translucent elastomer [Column 2, Line 65 – Column 3, Line 2 and Column 3, Lines 47-53].
3. In response to Applicant's argument regarding Claim 22 [Pages 11-12], specifically to the covering layer including material that is elastically compressible, it remains clear that Misaras teaches a translucent covering layer [Figure 1: (102, 104)] that is elastically compressible, whereby Misaras discloses (104) as a cushion/foam layer [Column 2, Line 66]. In addition, Misaras clearly teaches the elastomer including a

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<sup>1</sup> translucent. (2008). In *Merriam-Webster Online Dictionary*.

Retrieved December 22, 2008, from <http://www.merriam-webster.com/dictionary/translucent>

<sup>2</sup> translucent (2008). In *Webster's Revised Unabridged Dictionary*.

Retrieved December 22, 2008, from [http://dictionary.reference.com/browse/translucent#dict\\_header](http://dictionary.reference.com/browse/translucent#dict_header)

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hardness of 20 to 70 Shore A, and discloses, "Shore Hardness values between 60-100A, preferably between 70-90, and all values therebetween" [Column 3, Lines 21-23].

4. Applicant's arguments with respect to Claim 44 [Page 10] have been considered but are moot in view of the new ground(s) of rejection. At present, the prior art to Misaras remains commensurate to the scope of the claim as stated by the Applicant within the context of the claim language and as broadly interpreted by the Examiner [MPEP 2111], which is elucidated and expounded upon by the Examiner below.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 16-17, 20-21, 23, and 46 are rejected under 35 U.S.C. 102(e) as being anticipated by Misaras (U.S. Patent 6,652,128 B2).

7. With regards to Claim 16, Misaras discloses a lining element for an interior of a motor vehicle [Abstract] including:

- A base part [Figure 1: (106, 108, 110)];
- A surface side facing the interior of the vehicle and suitable for emitting light [Figure 1: (102)];

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- At least one mirror surface distributed in the lining element to reflect light therefrom [Figure 1: (108); Column 3, Lines 51-53]; and
- A translucent covering layer [Figure 1: (102, 104)], wherein the covering layer is designed to be elastically compressible,
- Wherein the translucent covering layer includes a translucent elastomer that has an at least partially foamed structure [Column 2, Line 65 – Column 3, Line 2 and Column 3, Lines 47-53].

8. With regards to Claim 17, Misaras discloses the base part [Figure 1: (108, 110)] being a light generator [Column 3, Line 30].

9. With regards to Claim 20, Misaras discloses the base part [Figure 1: (108, 110)] including at least one of an electroluminescent film, organic light-emitting diode and poly light-emitting diode [Column 3, Line 34].

10. With regards to Claim 21, Misaras discloses the elastomer is at least one of ethylene propylene dien monomer, silicone and polyurethane [Column 3, Line 1].

11. With regards to Claim 23, Misaras discloses the base part being designed as a plate-like optical conductor [Figure 1: (106, 108)], which is operationally associated with a light generator [Figure 1: (110)].

12. With regards to Claim 46, Misaras discloses the at least one mirrored surface being an angled mirrored surface [Figure 1: (108); Column 3, Lines 51-53].

13. Claim 22 is rejected under 35 U.S.C. 102(e) as being anticipated by Misaras (U.S. Patent 6,652,128 B2).

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14. With regards to Claim 22, Misaras discloses a lining element for an interior of a motor vehicle [Abstract] including:

- A base part [Figure 1: (106, 108, 110)];
- A surface side facing the interior of the vehicle and suitable for emitting light [Figure 1: (102)];
- At least one mirror surface distributed in the lining element to reflect light therefrom [Figure 1: (108); Column 3, Lines 51-53]; and
- A translucent covering layer [Figure 1: (102, 104)], wherein the covering layer includes material that is both translucent and is elastically compressible,
- Wherein the translucent covering layer includes an elastomer that is at least one of ethylene propylene diene monomer, silicone and polyurethane [Column 2, Line 65 – Column 3, Line 2];
- Wherein the elastomer having a hardness of 20 to 70 Shore A [Column 3, Lines 21-23].

15. Claims 24-25 are rejected under 35 U.S.C. 102(e) as being anticipated by Misaras (U.S. Patent 6,652,128 B2).

16. With regards to Claim 24, Misaras discloses a lining element for an interior of a motor vehicle [Abstract] including:

- A base part [Figures 1, 3: (314)];
- A surface side facing the interior of the vehicle and suitable for emitting light [Figures 1, 3: proximate (304A,B,C)];

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- At least one mirror surface distributed in the lining element to reflect light therefrom [Figure 1: (108); Column 3, Lines 51-53]; and
- A translucent covering layer [Figures 1, 3: (102, 104, 302)], wherein the covering layer includes material that is both translucent and is elastically compressible,
- Wherein the base part is designed as a plate-like operator, which is operationally associated with a light generator [Figure 1: (110); Column 4, Lines 24-25], and
- Wherein the optical conductor includes at least one of polymethyl methacrylate and polycarbonate material having a structure allowing an output of light on a surface side facing the interior of the vehicle [Column 4, Lines 48-56].

17. With regards to Claim 25, Misaras discloses the covering layer including a layer of a gel-like substance [Figure 1: (104)] covered toward the interior of the vehicle by a plastic film [Figures 1, 3: (102, 302)].

***Claim Rejections - 35 USC § 103***

18. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

19. Claims 26-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Misaras (U.S. Patent 6,652,128 B2).

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Misarar discloses the claimed invention as cited above, but does not specifically teach the plastic film has a thickness of 0.1 to 1.5 mm (re: Claim 26); the covering element having an overall thickness of 1.0 to 5.0 mm (re: Claim 27); or the gel-like substance having a dynamic viscosity of 0.01 to 10 Pa·s (re: Claim 28).

However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the plastic film to have a thickness of 0.1 to 1.5 mm; the covering element to have an overall thickness of 1.0 to 5.0 mm; and the gel-like substance to have a dynamic viscosity of 0.01 to 10 Pa·s, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art [*In re Aller*, 105 USPQ 233]. In this case, one would want the film/covering element to be of a relative thinness, as well as have a specific dynamic viscosity, in order to ensure that the gel-like substance is relatively flexible or deformable.

20. Claim 30 is rejected under 35 U.S.C. 103(a) as being unpatentable over Misaras (U.S. Patent 6,652,128 B2).

Misarar discloses the claimed invention as cited above, but does not specifically teach the translucent covering layer having an optical transmissivity in a visible spectral range of 1 to 25%.

However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the translucent covering layer to have an optical transmissivity in the visible spectral range of 1 to 25%, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering



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the optimum or workable ranges involves only routine skill in the art [*In re Aller*, 105 USPQ 233]. In this case, one would want to provide the translucent covering layer with an optical transmissivity for its intended purpose, such as a non-overbearing illumination.

21. Claims 31-32, 35-36, 38-43, 45, and 47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Misaras (U.S. Patent 6,652,128 B2).

22. With regards to Claim 31, Misaras discloses a lining element [Abstract] including:

- A base part [Figure 1: (108, 110)];
- A surface side facing an interior of a vehicle and suitable for emitting light [Figure 1: proximate (102)];
- At least one mirror surface distributed in the lining element to reflect light therefrom [Figure 1: (108); Column 3, Lines 51-53]; and
- A covering layer, wherein the covering layer is translucent [Figure 1: (102, 104, 106)].

Misaras does not specifically teach the translucent covering layer having an optical transmissivity in a visible spectral range of 5 to 10%.

However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the translucent covering layer to have an optical transmissivity in the visible spectral range of 5 to 10%, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art [*In re Aller*, 105 USPQ 233]. In this case, one would want to provide the translucent covering layer with

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an optical transmissivity for its intended purpose, such as a non-overbearing illumination.

23. With regards to Claim 32, Misaras discloses the claimed invention as cited above, and teaches the covering layer being generally elastically compressible [Column 2, Line 65 – Column 3, Line 2].

24. With regards to Claim 35, Misaras discloses the claimed invention as cited above, and teaches the translucent covering layer including an elastomer including an at least partially foamed structure [Figure 1: (102, 104, 106); Column 2, Line 66].

25. With regards to Claim 36, Misaras discloses the claimed invention as cited above, and teaches the elastomer including at least one of ethylene propylene diene monomer, silicone and polyurethane material [Figure 1: (102, 104, 106); Column 3, Line 1].

26. With regards to Claim 38, Misaras discloses the covering layer including a layer of a gel-like substance [Figure 1: (104)] covered toward the interior of the vehicle by means of a film [Figure 1: (102)].

27. With regards to Claim 39, Misaras discloses the film including a plastic material [Column 2, Line 64 - Column 3, Line 27].

28. With regards to Claim 40, Misaras discloses the claimed invention as cited above, but does not specifically teach the gel-like substance having a dynamic viscosity of 0.01 to 1 Pa·s.

However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the gel-like substance to have a dynamic

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viscosity of 0.01 to 1 Pa·s, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art [*In re Aller*, 105 USPQ 233]. In this case, one would want the gel to have a specific dynamic viscosity as identified above, in order to ensure that the gel-like substance is relatively flexible or deformable while maintaining stiffness/hardness.

29. With regards to Claim 41, Misaras discloses the claimed invention as cited above. In addition, Misaras teaches the gel-like substance [Figure 1: (104)] being arranged between two layers [Figure 1: (102, 106)], whereby one of the layers [Figure 1: (102)] is a plastic film [Column 3, Line 3]. Misaras does not specifically teach the other of the films being plastic.

However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the films out of plastic, since it has been held to be within general skill of a worker in the art to select a known material on the basis of its suitability for the intended use. *In re Leshin*, 125 USPQ 416. In this case, the availability of plastic is conducive to manufacturability and would be suitable for its stiffness/hardness characteristic.

30. With regards to Claims 42, Misaras discloses the claimed invention as cited above, but does not specifically teach the plastic films having a thickness of approximately 0.5 to 1.0 mm.

However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the plastic films to have a thickness of

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approximately 0.5 to 1.0 mm, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art [*In re Aller*, 105 USPQ 233]. In this case, one would want to ensure the films to be of a relatively thinness, so that they provide an aesthetically pleasing yet durable material.

31. With regards to Claim 43, Misaras discloses the claimed invention as cited above, but does not specifically teach the covering layer having a thickness overall of approximately 2.0mm to approximately 3.0mm.

However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to the covering layer to have a thickness overall of approximately 2.0 to approximately 3.0 mm, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art [*In re Aller*, 105 USPQ 233]. In this case, one would want to ensure that the covering element to be of a relatively thinness, so that it take up too much space yet is still an aesthetically pleasing and durable material.

32. With regards to Claim 45, Misaras discloses the claimed invention as cited above. In addition, Misaras teaches the base part [Figure 1: (108, 110)] including at least one of an electroluminescent film, organic light-emitting diode and poly light-emitting diode [Column 3, Line 34].

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33. With regards to Claim 47, Mirasas discloses the claimed invention as cited above, and teaches the at least one mirrored surface being an angled mirrored surface [Figure 1: (108); Column 3, Lines 51-53].

34. Claim 37 is rejected under 35 U.S.C. 103(a) as being unpatentable over Misaras (U.S. Patent 6,652,128 B2) as applied to Claim 35 above, and further in view of Miller (U.S. Patent 6,227,689 B1).

Misaras discloses the claimed invention as cited above, but does not specifically teach the elastomer having a hardness of APPROXIMATELY (broad interpretation – MPEP 2111) 40 Shore A.

Miller teaches, “Preferably, body 16 of bulb holder 10 is injection molded with at least two stampings 46. Body 16 may be molded from a flexible polymeric material, preferably having a Shore A durometer hardness of between approximately 50 Shore A and 105 Shore A, more preferably between approximately 60 Shore A and 90 Shore A, and most preferably approximately 60 Shore A, such as a thermoplastic elastomer (TPE) material, such as Kraton G7720B or the like. Alternatively, a plasticized poly vinyl chloride (PVC) material, a flexible urethane, a silicone or the like may be used, without affecting the scope of the present invention. By injection molding of body 16 with the stampings within the flexible material, the present invention assures a water-tight construction to substantially preclude water from entering the terminals 20 and 24 within body 16” [Column 5, Lines 29-44].

It would have been obvious to one ordinarily skilled in the art at the time of invention to modify the lining element of Misaras, specifically the elastomer, to

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incorporate the Shore durability characteristics, as principally taught by Miller, so as to ensure appropriate hardness and flexibility of the elastomer. It has also been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art [*In re Aller*, 105 USPQ 233].

35. Claim 44 is rejected under 35 U.S.C. 103(a) as being unpatentable over Misaras (U.S. Patent 6,652,128 B2).

36. With regards to Claim 44, Misaras discloses a lining element [Abstract] including:

- A base part [Figure 2: top of (222)];
- A surface side facing an interior of a vehicle and suitable for emitting light [Figure 2: (212)];
- At least one mirror surface distributed in the lining element to reflect light therefrom [Figures 1-2: (108, 208); Column 3, Lines 51-53]; and
- A covering layer [Figure 2: (202, 204)],
- Wherein the base part is designed as a generally plate-like optical conductor [Figure 2: top of (222)], and
- Wherein the optical conductor is configured to conduct light to the covering layer such that light exits from the surface side and to the interior of the vehicle [Column 4, Lines 12-16].

Misaras does not specifically teach the base part including at least one of polymethyl methacrylate and polycarbonate material.

However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have incorporated the base part to include at least one of polymethyl methacrylate and polycarbonate material, since it has been held to be within general skill of a worker in the art to select a known material on the basis of its suitability for the intended use. *In re Leshin*, 125 USPQ 416. In this case, polymethyl methacrylate and polycarbonate material are suitable for their light transmissive properties, hardness, durability, availability, and cost.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JASON M. HAN whose telephone number is (571)272-2207. The examiner can normally be reached on 8:00am-5:00pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sandra O'Shea can be reached on (571) 272-2378. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Jason M Han  
Examiner  
Art Unit 2875

/JMH/  
Monday, December 22, 2008

/Sandra L. O'Shea/  
Supervisory Patent Examiner, Art Unit 2875